

REMARKS

Applicants' undersigned attorney thanks the Examiner for the Examiner's comments. Applicants respectfully request reconsideration of this patent application, particularly in view of the above Amendment and the following remarks. Currently, Claims 1 and 3-29 are pending, with Claims 21-29 withdrawn from consideration.

Amendments to the Claims

Claims 1 and 3-20 have been examined, and no claims have been allowed.

Claims 1, 8 and 16 have been amended to eliminate any vague and indefinite terms. Claim 1 has been further amended to include the limitations of Claim 15. Thus, Applicants respectfully request cancellation of Claim 15.

No new matter has been added by this Amendment. No additional fee is required because the number of independent claims remains unchanged and the total number of claims has been reduced.

Claim Rejections - 35 U.S.C. §112

Claims 1 and 3-20 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants have amended Claims 1, 8, and 16 by removing the vague and indefinite terms.

In particular, Claim 8 has been amended to include the upper and lower limits set forth in paragraph [0039] of the published application. Claim 16 has been amended to clarify that the amount of time above the austenizing temperature is less than or equal to 10 minutes. In other words, the claimed time period may range from 0 minutes to 10 minutes.

In view of these amendments, Applicants respectfully submit that amended Claims 1, 8, and 16, and all claims depending therefrom are not indefinite. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claim Rejections - 35 U.S.C. §102

The rejection of Claims 1, 3-9, 14, and 20 under 35 U.S.C. §102(b) as being anticipated by Kefferstein et al. (U.S. Patent 6,564,604) is respectfully traversed.

The Kefferstein reference fails to disclose the formation of hardened structural parts having cathodic corrosion protection, as recited in Applicants' amended Claim 1. In particular, the Kefferstein reference fails to disclose methods that employ shaping and trimming steps, as well as punching and arrangement of a perforated pattern on the structural part, that are performed in such a way that the shaped part is embodied to be 0.5% to 2.0% smaller than the *finished* structural part.

Thus, the Kefferstein reference fails to disclose each and every limitation of amended Claim 1. Since Claims 3-9, 14, and 20 depend from Claim 1, either directly or indirectly, these claims are also not anticipated by the Kefferstein reference.

For at least the reasons given above, Applicants respectfully submit that the teachings of Kefferstein et al. fail to disclose Applicants' claimed invention. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claim Rejections - 35 U.S.C. §103

A. Kefferstein et al. in view of Imai et al.

The rejection of Claims 10-13, 16, and 17 under 35 U.S.C. §103(a) as being unpatentable over Kefferstein et al. (U.S. Patent No. 6,564,604) in view of Imai et al. (European Patent No. 1,439,240) is respectfully traversed.

As indicated above, the Kefferstein reference fails to disclose the formation of hardened structural parts having cathodic corrosion protection, particularly using methods that employ shaping and trimming steps, as well as punching and arrangement of a perforated pattern on the structural part, that are performed in such a way that the shaped part is embodied to be 0.5% to 2.0% smaller than the finished structural part.

As explained in paragraph [0057] of the subject application, the shaped part, which is shaped in its cold state, is produced smaller by 0.5 to 2.0% than the nominal geometric shape of the finished structural part, so that heat expansion in the course of heating is compensated.

The Kefferstein reference fails to disclose or suggest a method for producing hardened structural parts from sheet steel, wherein the hardened structural parts have cathodic corrosion protection, and heating the shaped part under the admission of atmospheric oxygen to a temperature which permits austenizing of the steel material is

performed subsequent to performing the final trim, punching, and/or the creation of a perforation pattern on the shaped part, such that the shaped part is embodied to be 0.5% to 2.0% smaller than the finished structural part.

The Imai reference fails to overcome the deficiencies of the Kefferstein reference. Like Kefferstein et al., Imai et al. also fail to disclose or suggest a method for producing a hardened steel part having cathodic corrosion protection, wherein shaping and trimming steps, as well as punching and arrangement of a perforated pattern on the structural part, are performed in such a way that the shaped part is embodied to be 0.5% to 2.0% smaller than the finished structural part, as recited in Applicants' claimed invention.

Furthermore, as pointed out and explained in Applicants' previous response, the coatings described in the Kefferstein reference do not even provide a sufficient galvanic protection for the surface of the steel parts. As also pointed out and explained in Applicants' previous response, Imai does not teach the same coating process as claimed by Applicants', as directly afterwards a galvanealing step in an oxidizing atmosphere is processed, which is not done in Applicants' claimed invention. Therefore, the zinc layer of Imai is transformed into a zinc oxide layer, whereas in Applicants' claimed invention the zinc layer is not oxidized but a surface of aluminum oxide protects the zinc from oxidizing.

Consequently, there is no suggestion or motivation for a person skilled in the art to combine the teachings of Imai with the teachings of Kefferstein. Even if a person skilled in the art combined the teachings of these two references, the resulting method would be much different than Applicants' claimed invention, since neither of these two references, alone or in combination, discloses or suggests the formation of hardened structural parts have cathodic corrosion protection, and neither of these two references, alone or in combination, discloses or suggests using methods that employ shaping and trimming steps, as well as punching and arrangement of a perforated pattern on the structural part, that are performed in such a way that the shaped part is embodied to be 0.5% to 2.0% smaller than the finished structural part.

For at least the reasons given above, Applicants respectfully submit that the teachings of Kefferstein et al. in view of Imai et al. fail to disclose or suggest Applicants'

claimed invention. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

B. Kefferstein et al.

The rejection of Claims 15, 18, and 19 under 35 U.S.C. §103(a) as being unpatentable over Kefferstein et al. (U.S. Patent No. 6,564,604) is respectfully traversed.

As explained above, the Kefferstein reference fails to disclose or suggest the formation of hardened structural parts having cathodic corrosion protection, particularly using methods that employ shaping and trimming steps, as well as punching and arrangement of a perforated pattern on the structural part, that are performed in such a way that the shaped part is embodied to be 0.5% to 2.0% smaller than the finished structural part, as recited in Applicants' claimed invention.

Applicants respectfully disagree with the assertion in the Office Action that “[i]t would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to choose any size for the shaped part such that the final shaped part having a desired shape, since...discovering the optimum or workable ranges (i.e., size of shaped part) involves only routine skill in the art.” To the contrary, the new limitations in Applicants' amended Claim 1 are dependent on the methods used to shape, trim, punch, and arrange a perforated pattern on the structural part, as well as the order in which these steps are carried out with respect to heating the part, and the techniques used for providing the corrosion protection, as described above. Thus, the limitation of enlarging the structural part by about 0.5 to 2.0% is not a design choice, since it is not directed at a certain size (e.g. width or thickness) of the structural part.

In view of the shortcomings of the Kefferstein reference explained above with respect to Applicants' amended Claim 1, none of the claims depending from Claim 1 would be obvious matters of design choice because Kefferstein fails to disclose or suggest the general conditions of Applicants' claimed invention.

For at least the reasons given above, Applicants respectfully submit that the teachings of Kefferstein et al. fail to disclose or suggest Applicants' claimed invention. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Conclusion

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner feels that any issues remain regarding this Amendment, then Applicants' undersigned attorney would like to discuss the case with the Examiner. Applicants sincerely believe that this Patent Application is now in condition for allowance and, thus, respectfully request early allowance.

Applicants are filing a Request for Continued Examination simultaneously with the filing of this Amendment.

Included herewith is payment for the appropriate fee under 37 C.F.R. § 1.17(e) for the Request for Continued Examination filed herewith. Applicants believe no additional fees are due with respect to this filing. However, should the Office determine additional fees are necessary, the Office is hereby requested to contact the undersigned to arrange for payment.

Respectfully submitted,

/Melanie I. Rauch/
SIGNATURE OF PRACTITIONER
Melanie I. Rauch, Reg. No. 40,924
Setter Roche LLP
Telephone: (720) 562-2280
E-mail: melanie@setterroche.com

Correspondence address:

CUSTOMER NO. 76444
Setter Roche LLP
P.O. Box 780
Erie, CO 80516